



## **GIBB & RAHMAN, LLC**

A LIMITED LIABILITY COMPANY  
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WRITER'S E-MAIL: SUPPORT@GIBB-RAHMAN.COM

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Re: In re patent application of: Agrawal, et al., Atty. Docket No.: ARC920030034US1, Serial No.: 10/624,069, Group Art Unit: 2161, Filed: July 21, 2003, Examiner: Padmanabhan, Kavita,  
For: MINING ASSOCIATION RULES OVER PRIVACY PRESERVING DATA

On July 3, 2008 a “SUBMISSION UNDER 37 CFR §1.114 IN SUPPORT OF REQUEST FOR CONTINUED EXAMINATION” was filed in the above-referenced application. This submission included three attachments: ATTACHMENT A, ATTACHMENT B, AND ATTACHMENT C. ATTACHMENT C was a “PETITION UNDER 37 C.F.R. §1.147(a) TO PERMIT ACCEPTANCE OF 37 C.F.R. AFFIDAVIT WITHOUT THE SIGNATURE OF ONE OF THE INVENTORS” and included four attachments: Attachment (a)-(d). Attachment (a) to the petition was a statement of Van Nguy and referenced sixteen exhibits (EXHIBITS (1)-(16)). The referenced exhibits were labeled incorrectly with one exhibit mistakenly not included. Therefore, enclosed please find the correctly labeled EXHIBITS (1)-(16) to Van Nguy's statement (i.e., to Attachment (a) of ATTACHMENT C to the submission).

Thank you for your consideration and assistance in this matter.

Respectfully submitted,

Dated: 7/7/08

/Pamela M. Riley/

Pamela M. Riley

Registration No. 40,146

Gibb & Rahman, LLC  
2568-A Riva Road, Suite 304  
Annapolis, MD 21401  
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From: Van Nguy/Almaden/IBM  
To: rakesh.devnull@[REDACTED], rakesh.prof@[REDACTED], ragrawal@[REDACTED]  
rakesh.agrawal@[REDACTED]  
Date: 05/15/2008 03:09 PM  
Subject: \*IBM Confidential: Signature needed to declare that you invented first

Hi Rakesh -

Re: US patent application 10/624,069 (Publication No 20050021488A1)  
Entitled: Mining Association Rules over Privacy Preserving Data

The above case is still under examination at the United States Patent and Trademark Office (USPTO). The USPTO has cited an article (Rizvi et al) that was published before the filing of the above application, but after your article at ACM SIGKDD 2002 describing your invention. Rizvi actually cites your article as a reference.

To confirm to the Patent Office that you and your co-inventors invented before Rizvi, we must file a declaration signed by all inventors declaring that you invented first. We would like to prepare the declaration for your signature. We wanted to make contact with you first to make sure that you are open to receiving and signing the declaration.

Please let us know by THURSDAY MAY 22, 2008 if you approve us sending you the declaration for signature.

Best regards,

Van N. Nguy  
Attorney, IBM Almaden Research Center  
650 Harry Road, C4TA/J2B, San Jose, CA 95120  
[REDACTED]

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EXHIBIT 1

From: Van Nguy/Almaden/IBM  
To: ragrawal@[REDACTED], rakesh.agrawal@[REDACTED], rakesh.devnull@[REDACTED], rakesh.prof@[REDACTED]  
Date: 05/22/2008 03:42 PM  
Subject: Re: Signature needed to declare that you invented first

Hi Rakesh -

I wanted to follow up on the email below since I have not heard from you. Are you open to us sending you a declaration to sign regarding the below?

Best regards,

Van N. Nguy  
Attorney, IBM Almaden Research Center  
650 Harry Road, C4TA/J2B, San Jose, CA 95120  
[REDACTED]

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From: Van Nguy/Almaden/IBM  
To: rakesh.devnull@[REDACTED], rakesh.prof@[REDACTED], ragrawal@[REDACTED], rakesh.agrawal@[REDACTED]  
Date: 05/15/2008 03:09 PM  
Subject: \*IBM Confidential: Signature needed to declare that you invented first

Hi Rakesh -

Re: US patent application 10/624,069 (Publication No 20050021488A1)  
Entitled: Mining Association Rules over Privacy Preserving Data

The above case is still under examination at the United States Patent and Trademark Office (USPTO). The USPTO has cited an article (Rizvi et al) that was published before the filing of the above application, but after your article at ACM SIGKDD 2002 describing your invention. Rizvi actually cites your article as a reference.

To confirm to the Patent Office that you and your co-inventors invented before Rizvi, we must file a declaration signed by all inventors declaring that you invented first. We would like to prepare the declaration for your signature. We wanted to make contact with you first to make sure that you are open to receiving and signing the declaration.

Please let us know by THURSDAY MAY 22, 2008 if you approve us sending you the declaration for signature.

Best regards,

Van N. Nguy  
Attorney, IBM Almaden Research Center  
650 Harry Road, C4TA/J2B, San Jose, CA 95120

[REDACTED]

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From: Rakesh Agrawal <Rakesh.Agrawal@[REDACTED]>  
To: Van Nguy/Almaden/IBM@IBMUS  
Cc: [REDACTED]  
Date: 05/22/2008 11:10 PM  
Subject: RE: Signature needed to declare that you invented first

you and your co-inventors invented before Rizvi --- what does it mean?

**From:** Van Nguy [REDACTED]  
**Sent:** Friday, May 23, 2008 9:31 AM  
**To:** Rakesh Agrawal  
**Cc:** [REDACTED]  
**Subject:** RE: Signature needed to declare that you invented first

Hi Rakesh -

Thank you for your response.

It means that the Patent Office thinks that the attached article by Rizvi et al. ("the Rizvi article") is "prior art" to your invention because the Rizvi article was published in August 2002 and your patent application (entitled "Mining Association Rules Over Privacy Preserving Data") was filed in July 2003. However, in the US, if we can show that you and your co-inventors invented before the effective date of the reference (here, August 20, 2002), then the reference is not really "prior art."

One of the evidence we have that the Rizvi article is not prior art to your invention is a paper entitled "Privacy Preserving Mining of Association Rules" by you, your co-inventors (Alexandre Evfimievski and Ramakrishan Srikant) and Johannes Gehrke that includes a description of your the invention (as confirmed by Alexandre Evfimievski) and was published at ACM SIGKDD **July 2002**. The Rizvi article actually cites your article as reference [8].

The Patent Office requires, however, that to submit this evidence and to establish invention prior to the effective date of the reference (thus removing the Rizvi article as a "prior art"), we must submit a declaration signed by **all** the inventors saying as such.

So, if you are open to receiving the declaration for signature, we will go ahead and prepare the document and send to you (which we can do over email) for your signature. Please let us know if you are open to this.

*(See attached file: p682-rizvi.pdf)(See attached file: p217-evfimievski.pdf)*

Best regards,

Van N. Nguy  
Attorney, IBM Almaden Research Center  
650 Harry Road, C4TA/J2B, San Jose, CA 95120  
[REDACTED]

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**Rakesh Agrawal**

**<Rakesh.Agrawal@[REDACTED]>**

05/24/2008 02:22 PM

To Van Nguy/Almaden/IBM@IBMUS

cc "[REDACTED]"

Subject RE: Signature needed to declare that you invented first

Isn't it obvious that our invention was done before August 2002 since the SIGKDD paper containing the invention was published in July 2002?



From: Van Nguy/Almaden/IBM  
To: [REDACTED], Rakesh Agrawal <Rakesh.Agrawal@[REDACTED]>  
Date: 05/27/2008 09:12 AM  
Subject: RE: Signature needed to declare that you invented first

Hi Rakesh -

Notwithstanding that, we cannot submit the evidence to the USPTO unless we have a declaration signed by all the inventors. Based on the emails below, I will assume that you are willing to receive the declaration for review and signature. I will go ahead and have it prepared. I will forward it onto you as soon as it is ready.

Best regards,

Van N. Nguy  
Attorney, IBM Almaden Research Center  
650 Harry Road, C4TA/J2B, San Jose, CA 95120  
[REDACTED]

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From: Rakesh Agrawal <Rakesh.Agrawal@[REDACTED]>  
To: [REDACTED]  
Cc: Van Nguy/Almaden/IBM@IBMUS  
Date: 05/27/2008 10:26 AM  
Subject: RE: Signature needed to declare that you invented first

Ok, I can sign the declaration that our was done before July 2002.

**From:** Van Nguy [REDACTED]  
**Sent:** Wednesday, May 28, 2008 8:28 AM  
**To:** Rakesh Agrawal  
**Cc:** [REDACTED]  
**Subject:** Fw: Signature needed to declare that you invented first

Rakesh - Please find the attached for your review. Please sign the declaration and postal mail, email, or fax the original back to me at the number below. Best regards, Van

*(See attached file: Rizvi article.pdf)(See attached file: ALM 5074 1.131 declaration.doc)(See attached file: ARC920030034USI\_Attachment C.pdf)(See attached file: privacy preserving mining of association rules.pdf)*

Van N. Nguy  
Attorney, IBM Almaden Research Center  
650 Harry Road, C4TA/J2B, San Jose, CA 95120  
[REDACTED]

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From: Rakesh Agrawal <Rakesh.Agrawal@[REDACTED]>  
To: Van Nguy/Almaden/IBM@IBMUS  
Cc: [REDACTED]  
Date: 05/28/2008 08:42 AM  
Subject: RE: Signature needed to declare that you invented first

**I thought I was simply declaring that:**

Ok, I can sign the declaration that our invention was done before July 2002.

**From:** Van Nguy [REDACTED]  
**Sent:** Wednesday, May 28, 2008 1:22 PM  
**To:** Rakesh Agrawal  
**Cc:** [REDACTED]  
**Subject:** RE: Signature needed to declare that you invented first

Hi Rakesh -

The declaration provides a detailed description of the evidence as they directly relate to the current claims since your "invention" is legally defined by the claims, though described, supported, and enabled by the specification. For your convenience, I have attached the declaration again here for your signature and return by postal mail, email, or fax to us.

*(See attached file: ALM 5074 1.131 declaration.doc)*

We look forward to hearing from you.

Best regards,  
Van N. Nguy  
Attorney, IBM Almaden Research Center  
650 Harry Road, C4TA/J2B, San Jose, CA 95120  
[REDACTED]

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From: Rakesh Agrawal <Rakesh.Agrawal@[REDACTED]>  
To: Van Nguy/Almaden/IBM@IBMUS  
Cc: [REDACTED]  
Date: 05/28/2008 02:07 PM  
Subject: RE: Signature needed to declare that you invented first

Again: As I said earlier, I can sign the declaration that our invention was done before July 2002. The document you are asking me to sign seems to make representations beyond that!!!

From: Van Nguy/Almaden/IBM  
To: Rakesh Agrawal <Rakesh.Agrawal@[REDACTED]>  
Cc: [REDACTED]  
Date: 05/28/2008 04:15 PM  
Subject: RE: Signature needed to declare that you invented first

Hi Rakesh - Yes. Unfortunately, the declaration needs to say what "our" and "invention" means in relation to the cited reference, so the declaration specifies this. The blanket statement you propose may be insufficient and we did not want to have to come back to you for another signature. We know you are very busy. Attached again is the declaration for your convenience.

[attachment "ALM 5074 1.131 declaration.doc" deleted by Van Nguy/Almaden/IBM]

Best regards,

Van N. Nguy  
Attorney, IBM Almaden Research Center  
650 Harry Road, C4TA/J2B, San Jose, CA 95120  
[REDACTED]

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**From:** Van Nguy [REDACTED]  
**Sent:** Tuesday, June 03, 2008 10:28 AM  
**To:** Rakesh Agrawal  
**Cc:** [REDACTED]  
**Subject:** RE: Signature needed to declare that you invented first

Hi Rakesh - I went back to our outside counsel and asked them if we could provide you with a shorter declaration. Please see the attached shorter version of the declaration for your review and, hopefully, approval and signature.

*(See attached file: ALM 5074 1 131 declaration short version.doc)*

Best regards,

Van N. Nguy  
Attorney, IBM Almaden Research Center  
650 Harry Road, C4TA/J2B, San Jose, CA 95120  
[REDACTED]

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From: Rakesh Agrawal <Rakesh.Agrawal@[REDACTED]>  
To: Van Nguy/Almaden/IBM@IBMUS  
Cc: [REDACTED]  
Date: 06/03/2008 12:38 PM  
Subject: RE: Signature needed to declare that you invented first

What is meant by - earliest effective prior art date of Rizvi?

I have no way of knowing when Rizvi et al conceived their innovation. There is usually a gap between when the invention is conceived and when a paper containing an invention is published.

I told this to Laura – I can sign a declaration that says when we did the invention. Anything beyond, I am not comfortable.

Also, please don't send anything marked IBM confidential to me.

**From:** Van Nguy [REDACTED]  
**Sent:** Tuesday, June 03, 2008 1:54 PM  
**To:** Rakesh Agrawal  
**Cc:** [REDACTED]  
**Subject:** RE: Signature needed to declare that you invented first

Hi Rakesh -

I have asked the declaration be amended to remove references to terms of art (e.g., "earliest effective prior art date of Rizvi?") and replaced with an actual date (in this case, August 2002). So paragraph [0001] now begins:

The purpose of this declaration is to prove that we conceived the claimed invention prior to the August 2002 date of **Exhibit A**.

I hope this is a version meets with your approval. Thank you for all your attention to this matter.

*(See attached file: REVISED ALM 5074 1 131 declaration short version.doc)*

Best regards,

Van N. Nguy  
Attorney, IBM Almaden Research Center  
650 Harry Road, C4TA/J2B, San Jose, CA 95120  
[REDACTED]

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EXHIBIT 15

From: Rakesh Agrawal <Rakesh.Agrawal@[REDACTED]>  
To: Van Nguy/Almaden/IBM@IBMUS  
Cc: [REDACTED]  
Date: 06/03/2008 04:47 PM  
Subject: RE: Signature needed to declare that you invented first

I'm sorry I cannot sign this version. And frankly, I have spent way too much time iterating with you on it.

EXHIBIT 16